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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,229	08/20/2001	Kenneth N. Harel	CONTC.57582	6394

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EXAMINER
TRAN A, PHI DIEU N

ART UNIT	PAPER NUMBER
3637	

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/933,229	Applicant(s) HAREL, KENNETH N.	
	Examiner Phi D A	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27,29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-27, 29-30, drawn to a drywall joint assembly strip and a method of making a drywall joint protection strip device, classified in class 52, subclass 255.

II. Claim 28, drawn to a method of making a drywall joint protection strip device with a roller device, classified in class 29, subclass 895.3.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process; for example, the perforations, the ribs and grooves can each be punched and formed by a die separately.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Vern Schooley on 4/11/2002 a provisional election was made without traverse to prosecute the invention of I, claims 1-27, 29-30. Affirmation of this election must be made by applicant in replying to this Office action. Claim 28 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The disclosure is objected to because of the following informalities: Page 9-10 " In a preferred embodiment, I have found that from parallel groove 56 and ridges 58 perform satisfactorily" is confusing. It is unclear what applicant is trying to say.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 17 recites the limitation "said perforations" in line 10. There is insufficient antecedent basis for this limitation in the claim.

It appears "said perforations" is the same limitation as the "communication means". The claimed terminology needs to be consistent.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-3, 5-9, 12-13, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al (6295776) in view of Peterson (2012203).

Kunz et al (figure 1) shows a protective drywall joint device having a rigid elongated core (12) of a predetermined width, generally planar longitudinal edges, outer and inner surface, the core having an arcuate central portion in cross-section, a paper cover (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond at least one of said longitudinal edges to from at least one flexible flap (the edge of the cover which extends beyond the core) having an outwardly facing and an inwardly facing surface, the core being galvanized steel (col 3 line 22), the core being configured with a curved lengthwise cross-section (14) which has a generally convex outer surface and a concave inner surface, the flap having perforations (col 4 lines 51-55) extending therethrough throughout the length for flow of joint compound from one side to the other, the perforation being at least 1/64 of an inch (1/64 = .015625).

Kunz et al does not show the flap having lengthwise grooves with ridges interposed therebetween, perforations formed along the grooves.

Peterson (figure 1) shows a cover having lengthwise grooves (5) and ridges (7) on a flap of a cover to impart flexibility to the cover to compensate for the plaster shrinkage and expansion, perforations formed along the grooves to allow compound to connect the interior and outer surfaces.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having lengthwise grooves with ridges interposed interbetween, perforations formed along the grooves because it would enable the

cover to compensate for expansion and shrinkage in the plaster and a better attachment of the cover to a wall as taught by Peterson.

Per claim 9, Kunz et al as modified by Peterson shows all the claimed limitations except for the cover being constructed of at least three layers. Kunz et al discloses the paper being conventional GSM Sand Back stock paper.

Applicant's disclosure page 10 lines 11 to page 11 line 3 discloses any conventional stiff paper will suffice for the invention including paper with at least three layers.

It would have been obvious to one having ordinary skill in the art at the time of the invention to show Kunz et al's paper having three layers because the examiner takes Official Notice of the equivalence of paper with at least three layers and the conventional GSM stock paper for their use in the drywall trim devices art and the selection of any of these known equivalents to cover the edge of the drywall corner would be within the level of ordinary skill in the art.

11. Claims 4, 21-27, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Peterson(2012203) as applied to claim 1 above and further in view of Bergin (5544463).

Kunz et al as modified by Peterson shows all the claimed limitations except for the core being made of plastic.

Bergin (col 3 lines 39-43) discloses a corner bead made of either plastic or metal.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al's modified structure to show the core being made of plastic because it has been held to be within the general skill of a worker in the art to select a known

material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Per claims 21-24, 29 Kunz et al as modified shows all the claimed structures. The claimed method steps of making a drywall joint strip device would have been the obvious method steps of making Kunz et al's modified structures.

Per claims 25-26, Kunz et al as by Peterson and Bergin shows all the claimed limitations except for the core being formed by passing the core through an extrusion die.

Applicant's disclosure page 10 lines 5-7 discloses the method of forming a core using casting, molding, extruding, or roller-forming being well-known in the art.

It would have been obvious to one having ordinary skill in the art to at the time of the invention to modify Kunz et al's modified structures to show the core being formed by extrusion die because using an extrusion die to form a core is a well-known process in the art for forming a core as disclosed by applicant.

Kunz et al as modified by Peterson, Bergin and applicant's disclosure shows all the claimed structures. The claimed method steps of making a drywall joint strip device would have been the obvious method steps of making Kunz et al' modified structures.

Per claim 27, Kunz et al (col 3 lines 48-48) discloses the process of bonding the cover to the core by hot melt adhesive (per page 11 lines 4-5 of applicant's disclosure, the adhesive is the same as the glue).

12. Claims 1, 10-11, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Weldy (re34547).

Kunz et al (figure 1) shows a protective drywall joint device having a rigid elongated core (12) of a predetermined width, longitudinal edges, outer and inner surface, a paper cover (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond at least one of said longitudinal edges to from at least one flexible flap (the edge of the cover which extends beyond the core), a plurality of perforations on the flaps spaced equidistant on the outer surface.

Kunz et al does not show the flap having at least three/four grooves lengthwise and four ridges interposed therebetween, the flaps having perforations spaced equidistant along the grooves.

Weldy (col 3 lines 37-40) discloses a plurality of perforations(26, figure 1) spaced equidistant along the grooves, a plurality of grooves lengthwise and ridges interposed therebetween to allow for strong engagement with a plaster material/mud (col 3 lines 49-55).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having at least three/four grooves lengthwise and four ridges interposed therebetween, the flaps having perforations spaced equidistant along the grooves because it would enable strong engagement with a plaster material/mud to attach the cover to a wall as taught by Weldy.

Per claim 30, Kunz et al as modified by Weldy shows all the claimed limitations except for the grooves being spaced $1/8^{th}$ of an inch apart, said ribs being raised outwardly from the bottom of the respective said grooves at least $1/64^{th}$ of an inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to show the grooves being spaced $1/8^{th}$ of an inch apart, said ribs being raised outwardly from the bottom of the respective said grooves at least $1/64^{th}$ of an inch because it

would have been an obvious matter of design choice to show the grooves being spaced 1/8th of an inch apart, said ribs being raised outwardly from the bottom of the respective said grooves at least 1/64th of an inch since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

13. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Weldy(re34547).

Kunz et al (figure 1) shows a protective drywall joint device having a relatively rigid elongated core (12) formed with angular flanges(figure 3, the intersection of the planar(16 and the curving part (12)) terminating in longitudinal edges (figure 1, at 18), the core having a convex outer surface and a concave inner surface, cover (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond said longitudinal edges to form flexible flaps (the edge of the cover which extends beyond the core), each cover having an outwardly facing surface and an inwardly facing surface, a plurality of perforations on the flaps to provide for the communication of uncured joint compound between the inner and outer surface, the compound when dried inherently would form compound posts.

Kunz et al does not show the flap having elongated grooves lengthwise and ridges disposed in alternating fashion along the outwardly facing surface, the flaps having perforations along the grooves.

Weldy (col 3 lines 37-40) discloses a plurality of perforations(26, figure 1) along the grooves, a plurality of grooves lengthwise and ridges disposed in alternating fashion along at the

outwardly facing surface to allow for strong engagement with a plaster material/mud (col 3 lines 49-55).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having elongated grooves lengthwise and ridges disposed in alternating fashion along the outwardly facing surface, the flaps having perforations along the grooves because it would enable strong engagement with a plaster material/mud to attach the cover to a wall as taught by Weldy.

14. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al(6295776) in view of Weldy(re34547).

Kunz et al (figure 1) shows a drywall joint assembly strip device having an elongated core/core means (12), a cover/cover means (20) bonded to the core (col 3 lines 48-50) and configured to project laterally beyond said longitudinal edges to form at least one flexible flaps (the edge of the cover which extends beyond the core), each cover having an outwardly facing surface and an inwardly facing surface, a plurality of perforations/communication means on the flaps to provide for the communication of uncured joint compound between the inner and outer surface, the compound when dried inherently would form compound posts.

Kunz et al does not show the flap having compound directing means/moisture-directing means, longitudinal rib means/reinforcing means, the communication means being formed along the moisture directing means.

Weldy (col 3 lines 37-40) discloses a plurality of grooves/compound directing means/moisture directing means and ridges/rib/reinforcing means at the outwardly facing surface

to allow for strong engagement with a plaster material/mud (col 3 lines 49-55), the grooves/communicating means forming along the moisture directing means.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kunz et al to show the flap having compound directing means/moisture directing means, longitudinal rib/reinforcing means, the communicating means formed along the moisture directing means because it would enable strong engagement with a plaster material/mud to attach the cover to a wall as taught by Weldy.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different trim device and method of applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Phi Dieu Tran A
April 12, 2002